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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/771,878	01/30/2001	Sachiko Hiyoshi	010031	9017

23850 7590 01/21/2004

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EXAMINER

WEINSTEIN, STEVEN L

ART UNIT

PAPER NUMBER

1761

DATE MAILED: 01/21/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No. 09/771878	Applicant(s) HIYOSHI
Examiner S. WEINSTEIN	Group Art Unit 1761

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- ☒ Responsive to communication(s) filed on 9/22/03
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- ☒ Claim(s) 6-17 is/are pending in the application.
- Of the above claim(s) _____ is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☒ Claim(s) 6-17 is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☐ Claim(s) _____ are subject to restriction or election requirement

Application Papers

- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119 (a)-(d).
- ☐ All ☐ Some* ☐ None of the:
- ☐ Certified copies of the priority documents have been received.
- ☐ Certified copies of the priority documents have been received in Application No. _____.
- ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a))

*Certified copies not received: _____

Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____
- ☒ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Interview Summary, PTO-413
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Other _____

Office Action Summary

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 6-17 are rejected under 35 U.S.C. 112, first paragraph for containing New Matter.

Claims 6 and 7 recite that the pressure sensitive adhesive layer "consists" of a styrene butadiene-based rubber, an acryl based rubber, and a rosin based or a petroleum resin based material. The specification is not seen to support this new language that the adhesive only contains both rubbers and either a rosin or petroleum based material and nothing else. Neither the specification nor the claims as originally filed uses the term "consisting of". In fact, the claims as originally filed do not even recite an adhesive layer. Also, not only does the specification not specifically exclude additional components, the specification is only inconclusive as to the make up of the adhesive constituents. For example, beginning on page 8, it is disclosed that a pressure sensitive adhesive is produced by blending styrene-butadiene based rubber and acryl based rubber with a rosin based or petroleum resin based stickiness providing material, yet the three examples (i.e. adhesive and comparative adhesive b and c) are disclosed as being acryl based, "another" acryl based and a styrene butadiene based adhesive, respectively. Thus, the adhesive, which is disclosed as working the best, is not one consisting of styrene-butadiene rubber and acryl rubber, but only acryl rubber. For the above reasons, the phrase "consisting of" appears to be New Matter. Also, as an aside, the comparative data found on pages 12 and 13 of the specification would not be convincing evidence for any urging of unexpected results since there is no specificity as to the composition of the adhesives.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 6-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Iwata et al (Japanese 8-183570) in view of Clark et al (6,210,724) further in view of Airle (UK 2,137,212) and Lee (EP 101,251).

In regard to claims 6 and 7, Iwata et al discloses a packaged food comprising a food comprising an aqueous solution, a container comprising a plastic sheet comprising a surface portion, at least one vent hole provided in the surface portion, and at least one hole-sealing sheet for sealing the vent hole wherein the sheet comprises a base material and a pressure sensitive adhesive layer (i.e. an adhesive tape) provide on its base material for attaching said hole-sealing sheet to said surface portion surrounding the vent hole and wherein the adhesive layer can include acryl based rubber or styrene butadiene based rubber, and wherein the hole sealing sheet possesses both pressure sensitive and thermo-sensitive properties and has a vertical peeling strength within the ranges recited. Iwata et al employs the hole-sealing sheet for the same reasons that applicant employs the hole-sealing sheet; i.e. to act as a venting means when the adhesive becomes weaker and allows steam to escape from the package during heating of the contents when the temperature reaches a certain range. Clarke et al is relied on as further evidence of providing a food containing containers to be heated with a vent hole and a hole sealing sheet comprising a base layer and a pressure sensitive adhesive that weakens when exposed to a higher temperature.

Claims 6 and 7 appear to differ from Iwata et al and Clarke et al in the specific pressure sensitive adhesive employed. As noted above, the claims recite an adhesive consisting of styrene butadiene based rubber and acryl based rubber and either a rosin-based or a petroleum resin based material. Both Iwata et al and Clark et al not only disclose pressure sensitive adhesives that have thermo-sensitive properties so that the peeling strength is greatly reduced as the temperature rises but they also disclose that they can include styrene-butadiene based rubber or acryl based rubber. Since the art, taken as a whole, teaches to employ a pressure sensitive adhesive that has thermo-sensitive properties that causes the adhesive to lose peel strength when subjected to heat, the particular conventional adhesive one chooses too use is seen to have been an obvious optimization. Applicant is not the inventor of SBR, acryl rubber adhesives with rosin as evidenced by Airlie and Lee. Note, too, Clark et al discloses pressure sensitive adhesives with thermo-sensitive properties wherein the adhesive contains a major portion of SBR and a minor portion of an organic polymer. Since the specification gives no definition or examples of a petroleum based resin, it would appear that the adhesive of Clark et al meets this description. It is noted that applicant has not responded to the examiners request for applicant to submit any publications and patents that he is aware of concerning the recited adhesive and its properties. Applicant appears to be employing a known adhesive for its known properties and to modify Iwata et al and substitute one conventional adhesive for another for its art recognized and applicant's intended function is seen to have been obvious. Miizumo and Tanno et al are relied on as further evidence of venting holes covered by pressure sensitive adhesive. In regard to the dependent claims, the art taken as a whole is applied for the reasons given in Papers Nos. 6 and 9. The particular conventional plastics and whether the material is clear or white would have

been obvious matters of routine determination, if indeed not already taught by Iwata et al and the art taken as a whole.

All of applicant's remarks filed 9/22/03 have been fully and carefully considered but are not found to be convincing. The rejected is based on substituting one conventional adhesive for another. Although Iwata et al may rely on a foaming agent to cause the pressure sensitive to have thermo-sensitive properties, the art taken as a whole teaches the conventionality of other compositions employing other mechanisms besides using a foaming agent. Airlie and Lee are relied on to teach that applicant is not the first to combine the constituents. Whether the adhesives of Airlie and Lee would be thermo-sensitive at higher temperatures is unclear since Airlie and Lee do not address this environment. Note, too, the specification gives no concentration of adhesive constituents so that one could assume that the combination has thermo-sensitive properties in any proportion. Since Clark et al discloses pressure sensitive adhesives that are thermo-sensitive without foaming agents, the urging that Airlie teaches away from the teaching of Iwata et al is moot. Finally, beside the fact that the specific concentration of adhesive is not supported by the specification as originally filed, the composition appears to be conventional, and there is nothing on the record that evidences an unexpected result for using the specific ingredients.

Any inquiry concerning this communication from the examiner should be directed to Steven Weinstein whose telephone number is 571-272-1410. The examiner can generally be reached on Monday-Friday from 7:00 a.m. to 3:30 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Milton Cano can be reached on 571-272-1398. The fax phone number for the

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organization where this application is assigned is 703-872-9306 for both regular communications and for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

S. Weinstein/dh
December 9, 2003

SA Weinstein
STEVE WEINSTEIN
PRIMARY, PROSECUTOR 1761
1/11/04